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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,009	06/08/2001	Gregory J. Swartz	1651-0001	4534

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EXAMINER

NGUYEN, CAO H

ART UNIT PAPER NUMBER

2173

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/878,009

Applicant(s)

SWARTZ ET AL.

Examiner

Cao (Kevin) Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 4-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/6/06
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 4-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scott et al. (US Patent No. 5,675,752) in view of Knowlton et al. (US Patent No. 5,973,692).

Regarding claim 1, Scott discloses a method of accessing one or more computer files via graphical icon comprising step of: creating an icon including selected portions of the captured one or more graphical representation of the information content of the one or more computer files, wherein the icon graphically depicts at least a portion of the information content from the one or more computer files (see col. 11, lines 5-51); linking the icon to the application and to the one or more computer files and application for manipulating the file, creating an icon corresponding to a file including information (..the interactive applications and multimedia

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environment see col. 8, lines 6-45); the icon substantially depicting at least a portion of the information content from the computer file (templates provide functional for interactive applications; see col. 8, lines 5-67); storing the icon in a memory; displaying the icon; and invoking the file and an application for manipulating the file upon selection of the icon (..GUI for the interactive presentation editor, the icons are used to represent commonly used function; see col. 11, lines 5-51 and figures 18-22); however, Scott fails to explicitly teach capturing one or more graphical representations of one or more portions of information content of one or more computer files while an application is manipulating the one or more computer files.

Knowlton teaches capturing one or more graphical representations of one or more portions of information content of one or more computer files while an application is manipulating the one or more computer files (see col. 10, lines 10-60). It would have been obvious to one of ordinary skill in the art, having the teachings of Scott and Knowlton before him at the invention was made, to modify the interactive application of Scott to include the system to capture graphical representation, as taught by Knowlton. One would have been motivated to make such a combination in order to capture and generating a corresponding graphical icon forming a displayable image representing the graphics information.

Regarding claim 4, Scott et al. discloses capturing a graphical representation is initiated by a user input command while the application manipulating the one or more computer file are active (see col. 22, lines 5-56).

Regarding claim 5, Scott et al. discloses wherein the user input command is a keyboard (see figures 1-2).

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Regarding claims 6 and 7, Scott et al. discloses storing information related to an application for manipulating the one or more computer files in a memory along with the icon and displaying the icon window on a screen display (see col. 23, lines 5-55).

As claims 8-13 are analyzed as previously discussed with respect too claims 1-7 above.

Regarding claim 14, Scott et al. discloses of storing data related to files and corresponding applications each item the file and applications are opened and closed during session, and wherein the step of invoking the file and an application for manipulating the file and the application based on the stored data related to files and corresponding applications (see col. 24 lines 8-64 and figures 22a-22d).

Regarding claim 15, Scott et al. discloses wherein the data related to files and corresponding applications includes a document path, a document handle, an application path, and an application handle (see col. 27, lines 23-53).

As claims 16-18 are analyzed as previously discussed with respect too claims 1-7 and 14-15 above.

Claim 19 differs from claim 1 in that "providing a user interface for accessing a file based on a corresponding icon and a window on a display screen for displaying the plurality of icons" which read on Scott (see figures 3-14). One would have been motivated to make such a combination in order to capture and generating a corresponding graphical icon forming a displayable image representing the graphics information.

As claims 20-26 are analyzed as previously discussed with respect too claims 1-7, 14-15 and 19 above.

Claim 27 differs from claims 1 and 9 in that "using icons to switch between a plurality of files and corresponding applications on a computer having file system and an operating system user interface to the files within the file system, the file separate from the operating system user interface to the files within the file system" which read on Scott (see col. 33, lines 34-67). One would have been motivated to make such a combination in order to capture and generating a corresponding graphical icon forming a displayable image representing the graphics information.

As claims 27-38 are analyzed as previously discussed with respect too claims 1-7, 14-15, 19 and 27 above.

Claim 39 differs from claims 1, 9 and 27 in that "storing file to be manipulated by an application as a template file along with an icon corresponding to the file and data related to the application used to manipulating the template file which read on Scott (see col. 32, lines 7-67).

As claims 40-41 are analyzed as previously discussed with respect to claims 1 and 27.

### ***Response to Arguments***

Applicant's arguments filed on 04/17/06 have been fully considered but they are not persuasive.

Accordingly, the claimed invention as represented in the claim does not represent a patentable distinction over the art of record.

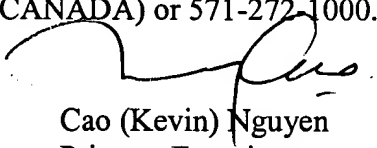
### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cao (Kevin) Nguyen whose telephone number is (571)272-4053. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on (571)272-4048. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cao (Kevin) Nguyen  
Primary Examiner  
Art Unit 2173

10/12/06